UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,631	04/06/2001	Joseph James Valorose III	D5009-00018	5521

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EXAMINER
RIES, LAURIE ANNE

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/828,631	VALOROSE, JOSEPH JAMES
	Examiner	Art Unit
	Laurie Ries	2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>06 April 2001</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-20</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>06 April 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____ .
4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____ .

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities:

- Page 5, line 15, "prevent" should read "present"

- Page 5, line 16, "[inventors?]" should be removed

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 18 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 18, the claimed invention is not tangibly embodied in a computer readable/executable medium because a carrier wave does not constitute a tangible medium.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 19 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Huang (U.S Publication 2001/0032217 A1).

As per claim 19, Huang discloses a system with an operating system on one computer and an application program on one computer. (See Huang, Figure 1A, and page 3, paragraphs 0038-0040). Huang also discloses an additional program for printing that manipulates a data stream generated by the application program to create a format independent document. (See Huang, page 5, paragraph 0056).

As per claim 20, Huang discloses the limitations of claim 19 as described above. Huang also discloses a parsing component, a formatting component, and a conversion module that performs the function as a file manager. (See Huang, page 3, paragraphs 0038 and 0044, and page 4, paragraph 0053).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-6 and 8-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang (U.S Publication 2001/0032217 A1) in further in view of Barile (U.S. Patent 6,560,621 B2).

As per claim 1, Huang discloses a method for generating electronic documents where data is received from an application program. (See Huang, page 3, paragraph 0035). Huang also discloses that a file is generated to store text data. (See Huang, Figure 4, element 418, and page 3, paragraph 0043). Huang does not disclose expressly that the data is divided into text and graphics data. Barile discloses that the text and graphics are separated, the graphics being converted into a graphic file format. (See Barile, Column 5, lines 6-21). Huang and Barile are analogous art because they are from the same field of endeavor of generating and formatting structured documents. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the division of text and graphics data of Barile with the method of generating electronic documents of Huang. The motivation for doing so would have been to provide an easier method for defining document elements and types in order to more efficiently associate these elements properly in a structured document. (See Huang, page 1, paragraph 0009). Therefore, it would have been obvious to combine Barile with Huang for the benefit of efficiently producing a structured document to obtain the invention as specified in claim 1.

As per claim 2, Huang and Barile disclose the limitations of claim 1 as described above. Huang also discloses that dividing the data separates the text portion with the glyph (or style) portion of the text data. (See Huang, Figure 8).

As per claim 3, Huang and Barile disclose the limitations of claim 1 as described above. Huang also discloses that at least three files are generated. (See Huang, Figure 4, element 418).

As per claim 4, Huang and Barile disclose the limitations of claim 3 as described above. Huang also discloses that one of the three files generated is an XML file. (See Huang, page 3, paragraph 0036).

As per claim 5, Huang and Barile disclose the limitations of claim 1 as described above. Huang also discloses that the user is permitted to specify at least one property of one of the files before it is generated. (See Huang, page 5, paragraph 0060, and page 6, paragraph 0067).

As per claim 6, Huang and Barile disclose the limitations of claim 5 as described above. Barile also discloses that a property specified is a location for the file. (See Barile, Column 5, lines 1-5). Huang and Barile are analogous art because they are from the same field of endeavor of generating and formatting structured documents. At the time of the invention it would have been obvious to a person of ordinary skill in the art to include the method for generating electronic documents in which the user is permitted to specify at least one property of a file before the file is generated, as disclosed by Huang and Barile, with the specific property being the location of the file, as disclosed by Barile. The motivation for doing so would have been to provide the information necessary to a print driver to allow the document to be printed. (See Barile, Column 4, lines 65-67). Therefore, it would have been obvious to combine Barile with Huaug for the benefit of printing the document.

As per claim 8, Huang and Barile disclose the limitations of claim 5 as described above. Huang also discloses that a property specified is an association table, equivalent to a template type. (See Huang, page 5, paragraph 0066, and page 6, paragraph 0067).

As per claim 9, Huang and Barile disclose the limitations of claim 1 as described above. Huang also discloses that the data is parsed to determine the data type. (See Huang, page 3, paragraph 0044). Huang also discloses that the data is formatted to allow for data presentation based on output need. (See Huang, page 3, paragraph 0045, and Figure 7).

As per claim 10, Huang and Barile disclose the limitations of claim 1 as described above. Huang also discloses that the data is sent to a conversion module, which performs the function of a file manager, after the file is divided but before a new file is generated. (See Huang, Figure 3A, and page 4, paragraph 0053).

As per claim 11, Huang and Barile disclose the limitations of claim 1 as described above. Huang also discloses that the application program has a word processing program. (See Huang, page 3, paragraph 0035).

As per claim 12, Huang and Barile disclose the limitations of claim 1 as described above. Huang also discloses that the generated file has a text portion in XML format. (See Huang, page 3, paragraph 0036). Barile also discloses that the generated file has a graphics portion. (See Barile, Column 5, lines 17-21). Huang and Barile are analogous art because they are from the same field of endeavor of generating and formatting structured documents. At the time of the invention it would have been

obvious to a person of ordinary skill in the art to include the method for generating electronic documents where a file for storing a portion of the text data or graphics data is generated, as disclosed by Huang and Barile, with the specific text portion in XML format, as disclosed by Huang, and a specific graphics portion of the generated file, as disclosed by Barile. The motivation for doing so would have been to allow for the use of a custom print driver that prints graphics data in files that are specifically identified by graphic file formats. (See Barile, Column 5, lines 17-21). Therefore, it would have been obvious to combine Barile with Huaug for the benefit of printing the graphics data in the document.

As per claim 13, Huang and Barile disclose the limitations of claim 12 as described above. Huang also discloses that the file has a font or glyph portion in XSL format. (See Huang, page 6, paragraphs 0072 and 0073, and Figure 10).

As per claim 14, Huang and Barile disclose the limitations of claim 1 as described above. Huang also discloses that the file as a format that is different from the file format of the original unstructured document from the application program. (See Huang, page 3, paragraph 0038).

Claim 15 is rejected on the same basis as claim 1 above. (See also Huang, Figure 1A).

Claim 16 is rejected on the same basis as claim 1 above. (See also Huang, page 3, paragraph 0039).

Claim 17 is rejected on the same basis as claim 1 above. (See also Huang, page 3, paragraph 0040 – 0043).

Claim 18 is rejected on the same basis as claim 17 above.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huang

and Barile as applied to claim 5 above, and further in view of DeRose (U.S. Patent

5,557,722).

As per claim 7, Huang and Barile disclose the limitations of claim 5 as described

above. Huang and Barile do not disclose expressly that a property specified is security

information for a file. DeRose discloses that attributes may be modified to provide

security for a document. (See DeRose, Column 8, line 67, and Column 9, lines 1-9).

Huang, Barile and DeRose are analogous art because they are from the same field of

endeavor of generating and formatting structured documents. At the time of the

invention it would have been obvious to a person of ordinary skill in the art to combine

the method of generating electronic documents of Huang and Barile with the modifiable

attribute based on security considerations of DeRose. The motivation for doing so

would have been to allow for user customization of the output data based on specific

concerns, such as providing security for the document. (See DeRose, Column 9, lines

2-5). Therefore, it would have been obvious to combine DeRose with Huang and Barile

for the benefit of providing document security to obtain the invention as specified in

claim 7.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Ellard (U.S. Patent 5,999,937) discloses a system and method for converting data between data sets having different data formats.

- Motoyama (U.S. Patent 5,506,985) discloses a method and apparatus for format conversion of a hierarchically structured page description language document.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laurie Ries whose telephone number is 703-605-1238. The examiner can normally be reached on Monday-Friday from 7:00am to 3:30pm.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LAR

JOSEPH FEILD
SUPERVISORY PATENT EXAMINER